



Patent
Attorney's Docket No. 021565-078

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Herman VAN MELLAERT et al.

Application No.: 09/661,016

Filed: September 13, 2000

For: RECOMBINANT PLANT
EXPRESSING NON-COMPETITIVELY
BINDING Bt INSECTICIDAL CRYSTAL
PROTEINS

Group Art Unit: 1638

Examiner: Kubelik, Anne R

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In complete response to the Official Action dated December 14, 2001, requiring restriction under 35 U.S.C. § 121, Applicants hereby elect, albeit with traverse, the claims of Group III, Claims 22, 24, and 26, drawn to a nucleic acid encoding a Bt14 protein and a plant transformed with that nucleic acid.

Applicants note the Examiner's argument, at pages 2-3 of the Official Action, that the claims of Group I and IV are unrelated because "they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects." However, the Examiner's attention is respectfully directed to the definition of "same patentable invention" in 37 C.F.R. § 1.601(n).

Invention "A" is the *same patentable invention* as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a *separate patentable invention* with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

Applicants submit that, in the case of the present claims, claim 20 is directed to the same patentable invention as claims 22, 24, and 26, and vice-versa. Claim 20 is directed to a protein with the amino acid sequence of the Bt14 protein, or an insecticidally active fragment thereof. Claims 22, 24, and 26 are directed to the class of DNA molecules that encode the amino acid sequence of the Bt14 protein. Applicants submit that this genus of DNA molecules is obvious in view of the amino acid sequence that they encode; likewise, Applicants submit that the amino acid sequence of the Bt14 protein would be obvious in view of any of DNA molecules encoding that protein. The same logic applies to Groups II and IV. Consequently, because claim 20 is directed to the *same patentable invention* as claims 22, 24, and 26, withdrawal of the Restriction Requirement, rejoinder of Groups I and III, and of Groups II and IV, and further and favorable consideration of all the claims of record on the merits is respectfully requested.

In the event that there are any questions relating to this application, the Examiner is respectfully requested to telephone the undersigned so that prosecution of this application may be expedited.

In the event that there are any questions concerning the present amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned so that prosecution of this application may be expedited.

Respectfully submitted,

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Date: 14 May 2002.